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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/663,618	06/14/1996	PATRICK W. GRAY	27866/32960	9362
7590	07/16/2002			
MARSHALL O'TOOLE GERSTEIN MURRAY & BORUN 6300 SEARS TOWER 233 SOUTH WACKER DRIVE CHICAGO, IL 606066402			EXAMINER	
			PROUTY, REBECCA E	
			ART UNIT	PAPER NUMBER
			1652	
			DATE MAILED: 07/16/2002	30

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>08/663,618</b>	Applicant(s) <b>Gray</b>
Examiner <b>Rebecca Prouty</b>	Art Unit <b>1652</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Feb 14, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-18 and 32 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 1-12 is/are allowed.

6)  Claim(s) 13-18 and 32 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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The request filed on 2/14/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/663,618 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 19-31 have been canceled. Claims 1-18 and 32 are still at issue and are present for examination.

Claim 32 of this application has been presented by the applicant as corresponding to a proposed count to provoke an interference with U.S. Patent No. 5,928,928. This claim is not patentable to the applicant because it fails to comply with the written description requirements of 35 USC 112 and is anticipated as discussed herein.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Claims 13-18 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 (upon which claims 14-18 depend and 32 are indefinite in the recitation of "stringent conditions" as the specification does not define what conditions constitute "stringent". While page 4 of the specification describes some

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conditions which are intended to be stringent, there is nothing to suggest that other conditions would not also be included within the scope of this term and in the art what is considered stringent varies widely depending on the individual situation as well as the person making the determination. As such it is unclear how homologous to the sequence of a gene encoding SEQ ID NO:2, a sequence must be to be included within the scope of these claims.

Claim 32 is indefinite in the recitation of "immunogenic fragment" as the scope of this term is unclear. Is this claim limited to fragments of SEQ ID NO:2 which will induce an antibody which specifically binds to SEQ ID NO:2 under some conditions?, to fragments which will induce any antibody which binds to SEQ ID NO:2 regardless of specificity? or does it include any fragment which will induce an antibody to itself?.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims are directed to a genus of DNA molecules comprising any DNA fragment which hybridizes to SEQ ID NO:1 under stringent conditions. The specification does not contain any

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disclosure of the function of all DNA sequences which hybridizes to SEQ ID NO:1 under stringent condition. The genus of DNAs that comprise these above DNA molecules is a large variable genus with the potentiality of encoding many different proteins. Therefore, many functionally unrelated DNAs are encompassed within the scope of these claims, including partial DNA sequences. The specification discloses only two species of the claimed genus which are insufficient to put one of skill in the art in possession of the attributes and features of all species within the claimed genus. Therefore, one skilled in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

Applicants appear to believe the amendment of Claim 32, filed 5/29/01 to "encoding a human chitinase of SEQ ID NO:2 or an immunogenic fragment thereof" limits the scope of the claimed genus to that which is clearly described by the specification. However giving the phrase "immunogenic fragment" its broadest reasonable interpretation, i.e., that it includes any fragment of SEQ ID NO:2 capable of inducing an antibody to itself, the claimed genus is still highly diverse with regards to structural and functional characteristics such that the two disclosed species cannot be considered to be representative of the genus. The claimed genus of polynucleotides includes fragments with use

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only as probes and/or primers, fragments which could be used to produced peptides with use in assaying and/or purifying human chitinase, and fragments which could be used to produce proteins with chitinase activity. The two disclosed species could be considered to be representative only of those polynucleotides which encode enzymatically active fragments of the human chitinase of SEQ ID NO:2.

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

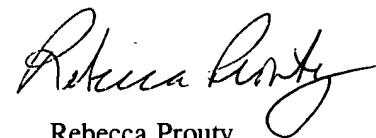
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pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty  
Primary Examiner  
Art Unit 1652